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Remarks/Arguments

Claims 19-33 are pending. Applicants have amended the claims to clarify the claim language. No new matter has been added to the prosecution of this application. For at least the reasons stated below, Applicants assert that all claims are now in condition for allowance.

35 U.S.C. § 103 Rejections

Claims 19, 21, 24, 26, 29 and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over *Buchanan* (US Patent 5,267,155) in view of *Edwards* (US Patent 5,410,551) in view of *Hobbs* (US Patent 6,523,022) in view of *Lee* (US Patent 6,535,883). Applicants respectfully oppose these rejections as not only do the references fail to teach all of the claim limitations, but the Examiner has failed to assert a valid motivation to combine these references.

Claim 19 is directed to generating error and summary reports for a data load, while storing user input data files in a multi-tier client/server architecture, comprising the steps of:

- (a) maintaining a connection between multiple user stations and a server having a database;
- (b) receiving from one of the user stations a plurality of user input data files;
- (c) receiving a plurality of user-selected keywords, wherein data contained within said user input data files is organized around the keywords;
- (d) selecting a data management template corresponding to the keywords;
- (e) validating that all data to be loaded into the database match the data management template by

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enforcing business rules/requirements and ensuring that referential integrity, codependency, primary key, required field, default field, sequence number, and hard-coded field checks are met;

- (f) loading the validated data into the database; and,
- (g) compiling a report identifying data that match the data management template and data that do not match the data management template.

A. The History of the Rejections

In the first Office action, the Examiner rejected the primary claim (i.e., claim 1, which dealt with generating error and summary reports for a data load) under 35 USC 103(a) as being unpatentable over *Buchanan* in view of *Edwards*. In response, Applicants deleted the first set of claims and introduced the new, more restricted claims, where the new primary claim (i.e., claim 19) also deals with generating error and summary reports for a data load, but further where the invention does so while storing user input data files in a multi-tier client/server architecture.

In the second Office action, the Examiner rejected the new primary claim 19 under 35 USC 103(a) as being unpatentable over *Buchanan* in view of *Edwards* in view of *Hobbs*. In other words, the Examiner added *Hobbs* as a third reference, stating that *Buchanan* plus *Edwards* plus *Hobbs* (i.e., B + E + H) makes Applicants' invention obvious. In response, Applicants further restricted claim 19 by requiring that the step of validating includes "enforcing business rules/requirements and ensuring that referential integrity, codependency, primary key, required field, default field, sequence number and hard-coded field checks are met".

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In the following Advisory Action, the Examiner said that the amendment raised new issue requiring further searching. Applicants then filed an RCE so that the further searching could be accomplished.

In the third Office action, the Examiner continued to reject claim 19 under 35 USC 103(a) as being unpatentable over *Buchanan* in view of *Edwards* in view of *Hobbs*. To teach the newly amended element, the Examiner extended the chain of references by adding *Lee*. In other words, the Examiner now asserts that B + E + H + L makes Applicants' invention obvious.

B. Stringing Together References is Not Enough for a Rejection

Applicants oppose the 103(a) rejection because it does not form a *prima facie* case of obviousness. In 1998, the Court of Appeals for the Federal Circuit reversed an Examiner's § 103 rejection that was issued by simply stringing together a series of prior art references, which the Court characterized as a "prior art mosaic." *In re Denis Rouffet, et al.*, No. 97-1492, 1998 WL 400169 (Fed. Cir.).

The *Rouffet* court was not surprised that the Examiner was able to show a combination of references that contained all of the claim elements since "virtually all inventions are combinations of old elements." *Id.* If the Examiner only had to identify each claimed element in the prior art, then "very few patents would ever issue" since an Examiner could merely "use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *Id.* Using the claim as such a blueprint is an "illogical and inappropriate process by which to determine patentability." *Id.* (citing *Sensonics, Inc. v. Aerosonic Corp.*, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)).

Earlier this year, the CAFC again addressed this issue. The CAFC held that an improper obviousness rejection might "break an invention into its component parts (A + B +

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C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious." *Richard Ruiz et al. v. A.B. Chance Co.*, No. 03-1333 (Fed. Cir., 2004). The "as of whole" requirement of § 103 prohibits such a form of "hindsight reasoning, using the invention as a roadmap [or blueprint] to find its prior art components" improper. *Id.*

In the present Application, the Examiner creates his § 103 obviousness rejection by breaking Applicants' invention into its component parts (B + E + H + L) and asserts four references to support the various components. Stringing together these four prior art references into a "prior art mosaic" by using the claims as a roadmap or blueprint is the very procedure that was overturned by the CAFC in both *Rouffet* and *Ruiz*, and is therefore improper.

C. The Four References are not Concerned with the Same Problem

Finding prior art references to cover each of the limitations in the claims is just a first step of a 103 rejection. In *Rouffet*, the CAFC acknowledged that the Board did not err when it found that the combination of the references contained all of the elements of the claims in the application. The problem found by the CAFC was that there was not an adequate showing that one skilled in the art would have been motivated to combine those references. The Examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*. In *Rouffet*, the Board did not explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely relied on the assertion that one skilled in the art would have a high level of skill and thus would recognize the ability to combine the references. The CAFC rejected this, stating that if "such a rote invocation could suffice to

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supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance." *Id.* Instead, the "Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection." *Id.*

Applicants are faced with a similar rejection: the Examiner does not offer a legitimate rationale for the combination of the five references that are directed to five distinct problems. Reviewing the references one finds the following problems that were trying to be solved by each reference:

Reference	Problem to Solve, and the Invention's General Solution for the Problem	Support within the Reference
<i>Buchanan</i> (5,267,155)	<u>Dictating and transcribing reports is time consuming, repetitive, and causes delay in getting the records available for review and use.</u> The invention provides a series of boiler-plate forms and allows a user to select phrases to be inserted in the holes of the form.	Background of the Invention (col 1, lines 25-65)
<i>Edwards</i> (5,410,551)	Electronic systems are made of a series of interconnected modules that can have their connections verified through JTAG's boundary scan architecture. <u>Six problems of verifying connections between these electronic modules</u> are explicitly explained: large amounts of test data need to be stored; the "walking ones and zeros" test	Background of the Invention (col 5, lines 3-69)

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	requires it be performed two times; keeping track whether a node should be a 0 or 1 is complicated; JTAG doesn't verify dynamic attributes of the interconnections; switches add undesirable delays to circuit paths; large amounts of circuit area and power are consumed	
Hobbs (6,523,022)	Both <u>push and pull methods of providing a web user with information have limitations</u> , and so this invention allows the user to use pull technology by clicking on hyperlinks in a HTML webpage while at the same time, those links cause information to be pushed to the user in a nearby frame or pop up window. The info pushed to the frame can be up-to-date information which is advantageous since the webpage itself may have stale information.	Background of the Invention section (col 1, line 45 to col 7, line 50)
Lee (6,535,883)	<u>Creating validation rules for electronic forms can take several weeks to create by a developer</u> . This invention provides a user friendly system for creating validation rules	Background of the Invention (col 2, lines 40-64)

The above table shows the vast differences among the four references. Especially noteworthy is *Edwards*. The *Edwards* invention is directed to solving six problems in

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verifying the physical interconnections among electronic components. The *Buchanan* invention is concerned with overcoming the time and repetition in dictation and transcription by using template forms. The *Hobbs* invention is directed to overcoming limitations of push and pull technology on the web by allowing the user to click on links to pull data and at the same time pushing relevant data to a nearby pop-up window. *Lee* offers a solution the need for waiting several weeks for a programmer to set up validation rules by having a user-friendly system for rule creation.

Applicants were faced with the problem of reporting the results of data loading (such as an error report and a summary report). Applicants were not faced with the problem of speeding up transcription and so one would not look to the *Buchanan* reference for help. Applicants were not worried about verifying the physical connections in an electronics system and so one would not look to the *Edwards* reference for help. Applicants were not worried about pulling and pushing data on a webpage and so one would not look to the *Hobbs* reference for help. Applicants were not worried about a way to create validation rules quickly and so one would not look to the *Lee* reference for help.

All four references are directed to solving four distinctly different problems (from one another and from the Applicants' problem) and so the Examiner cannot "show reasons that the skilled artisan, confronted with the same problems" would combine the references, as required by *In re Rouffet*.

D. The Examiner's Motivation is Merely Hindsight, Building a Mosaic of Prior Art

The Examiner gives the motivation to combine *Edwards* with *Buchanan* as the "motivation of detecting and preparing a summary report of matched and unmatched data in a database which better informs the user of any discrepancy involved with data being stored in the database" (Office action, page 4). One skilled in the art, at the time of the invention, would not look to *Edwards* and *Buchanan* in order to prepare such a summary

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report based on discrepancies in data stored in the database since the two references are directed to different problems, neither of which are related to this asserted motivation. Only by using hindsight can one pick and choose phrases from the two references to piece together a way to have portions of Applicants' claim read on these two references.

The Examiner gives the motivation to combine *Hobbs* with what is already taught in *Edwards* and *Buchanan* as the "motivation of connecting linked terms to data records or templates, thereby saving enormous labor and time cost involved in updating a database" (Office action, page 6). One skilled in the art, at the time of the invention, would not look to *Hobbs*' problem of improving push and pull technologies, combine that with *Edwards* and *Buchanan* in order to connect linked terms to templates. Only through hindsight does such a combination now arguably seem apparent.

The Examiner gives the motivation to combine *Lee* to the other three references as the "motivation to using validation rules to test the content of field entered by a user to ensure that field is filled out correctly thereby catching any errors before the user leaves the service site" (Office Action, page 7). One skilled in the art, at the time of the invention would not look to *Lee*'s problem of making validation rule creation user friendly to solve Applicants' problem of needing to generate reports for data loads. Adding *Lee* to the long equation (B + E + H + L) of references cannot be based on a similarity of problems in the references. It can only be based on hindsight.

Summary

The Examiner has not shown reasons that the skilled artisan, confronted with the same problems as the inventors and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed, as required by *Rouffet* since the four cited references are directed to four distinct problems. Therefore, the Examiner has failed to make his *prima facie* case of obviousness

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and the 35 USC § 103 rejections should therefore be withdrawn. Using the claim as a blueprint to chain together the four references in hindsight is an "illogical and inappropriate process by which to determine patentability." *Rouffet*.

Applicants submit that all pending claims are allowable over the art of record and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 612-607-7508. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 060021-340501).

Respectfully submitted,



Steven C. Lieske, Reg. No. 47,749

Customer No. 29,838

OPPENHEIMER WOLFF & DONNELLY LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55405
Phone: 612-607-7508
Fax: 612-607-7100
E-mail: SLieske@oppenheimer.com